

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kuriacose Joseph et al.	Examiner:	Yogesh Garg
Serial No.:	09/672,523	Group Art Unit:	3625
Filed:	September 27, 2000	Docket No.:	2050.001US3
Customer No.:	44367	Confirmation No.:	2175
Title:	METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Applicants respectfully request review of the rejection of claims specified below in the Office Action of June 11, 2009 as: (1) being based on a defective reissue declaration; and (2) as being barred under § 251 under the recapture doctrine. These same claims were previously rejected on the same bases in the Office Action of January 6, 2009; and are thus ripe for appeal. No amendments are submitted with this request.

This request is being filed with a Notice of Appeal. The review is requested for the reasons articulated below.

Substitute Oath/Declaration

The Examiner reiterated the rejection of claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 as being based upon a defective reissue declaration under 35 U.S.C. § 251. The Examiner stated that substitute reissue declaration filed on May 29, 2008 was found defective, as it does not identify the existence of an error, which error causes the original patent to be defective.¹

However, the Office Action ignores a corrected substitute reissue declaration filed with the previous response on March 30, 2009. The failure of the Office Action to address the substitute reissue declaration is clear from the language of the rejection, which takes issue with language of the declaration that is not present in the substitute reissue declaration of March 30,

¹ Detailed Action, page 6.

2009. Specifically, this substitute reissue declaration states as follows:

I believe original patent 5,819,034 to be wholly or partly inoperative by reason of my claiming less than I had the right to claim in the patent. Specifically, the patent discloses a method and system that, stated generally, facilitate the presenting of data about an item being offered for sale to a user, and in response to a single action by the user, generating an order for the item. This invention is distinct from the invention claimed in the original patent; and is not in any way claimed in the patent. This error is addressed in this reissue by including claims directed to method and system of facilitating ordering an item, where the order is placed in response to a single action by the user. In particular, the error is addressed by the presentation of claims 10, 28, 260, and their respective dependent claims, drawn to this previously unclaimed invention.

The substitute reissue declaration thus clearly identifies the existence of an error in the claims, due to the original claims not addressing the newly-addressed invention covered by the submitted claims. Applicants respectfully request that the declaration submitted March 30, 2009 be considered, and that the rejection be reversed.

§ 251 Rejection of the Claims

Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 were rejected under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based."² This exact rejection was previously raised in the Office Action mailed on July 9, 2003³ but later withdrawn in the Office Action mailed on May 03, 2007. At the time of withdrawal of the rejection, the (current) Examiner correctly stated the reason for withdrawing the rejection under 35 U.S.C. § 251 was that the subject matter of the claims (i.e., method and system of facilitating ordering an item, where the order is placed in response to a single action by the user) was "new and not related to the claimed subject matter surrendered in the application for the patent upon which the present reissue is based" (i.e., a system configured to receive and execute a distributed computing application that alters an associated video program). After this express withdrawal of the rejection in the Office Action of May 3, 2007, the rejection was inexplicably re-introduced by the Examiner in the subsequent Office Action (of January 6, 2009), and then maintained in the current Office Action. In the current Office Action, the Examiner states that claims 10-11,

² Office Action mailed June 11, 2009, page 7.

³ Office Action mailed on July 9, 2003, page 2.

13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 are broader than the patented claims 1-9 because they do not include limitations recited in the patented claims 1-9 and concludes that the claims are barred by the recapture rule. It appears that this position is founded on a misunderstanding of the prohibition against recapture. Specifically, the Office Action states that "claims claiming additional inventions or embodiments not originally claimed are permissible only if any claims amended during prosecution of the original application to obtain the patent are not deleted or broadened by reissue;" and "since the applicant has canceled all of the patented claims which were amended during prosecution of the original application to obtain the patent it is impermissible recapture."⁴ The Office action also states that in the present application "the applicant has deleted the claims that were amended and narrowed to obtain the patent in the original application and hence there is impermissible recapture."⁵

Thus, the Office Action clearly indicates that but for the original patented claims not being present in this reissue application, no recapture would be considered to exist. Applicants respectfully submit, however, that the absence or presence of the original claims in a reissue application has no bearing on whether claims for a different invention may be submitted (as is done here), and the presence, or absence, of such original claims is not a touchstone test as the Office Action tacitly asserts.

As previously noted by Applicants (in the response filed March 30, 2009), the recapture rule and the scenarios under which the recapture rule bars reissue claims are addressed in MPEP § 1412.02 titled "Recapture of Canceled Subject Matter." In pertinent part, MPEP § 1412.02 states that *if the reissue claims are claiming additional inventions or embodiments not originally claimed, then recapture is not present*, and that the complete removal of a limitation that was added to obtain the patent is permitted where the replacement limitation provides a separate invention.⁶ Applicant also identified that in the present reissue application (as expressly explained in the substitute reissue declaration of March 30, 2009), the now-pending claims are directed to method and system of facilitating ordering an item, where the order is placed in

4 See Office Action of June 11, 2009, page 3.

5 See Office Action of June 11, 2009, pages 4-5.

6 MPEP 1412.02 (I)(C). ("If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.")

response to a single action by the user, and thus the claims are related to a different invention than that claimed in the original patent (e.g., a system configured to receive and execute a distributed computing application that alters an associated video program).

As noted above, the present Office Action takes the position that “reissue claims claiming additional inventions or embodiments not originally claimed are permissible only if any claims amended during prosecution of the original application to obtain the patent are not deleted or broadened by reissue.”⁷ However, no such rule is imposed by 35 U.S.C. § 251 or by MPEP § 1412.02.

Space constraints here do not permit a complete addressing of the possible bases for the misconception stated in the Office Action. But MPEP § 1412.02 (I)(C) is clear in identifying a recapture analysis, but providing expressly that notwithstanding that recapture analysis, there is an express exception for claims directed to additional inventions/embodiments not originally claimed:

If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.⁸

This is exactly the situation presented here (as expressly acknowledged by the Examiner in the Office Action of May 3, 2007).

If the position espoused in the Office Action were correct, then a patentee would never be able to file multiple divisional applications from a reissue application to address different newly-claimed inventions, as § 101 restrictions on double patenting would preclude the original claims from being present in each such divisional application. Yet such divisional applications are clearly permitted. In fact, the originally issued claims of the patent under reissue here are found within such a divisional reissue application, serial number 09/903,458, filed July 10, 2001.

As discussed above, and as also explained in the previous communications, in the present reissue application the claims are directed to method and system of facilitating ordering an item, where the order is placed in response to a single action by the user. The invention claimed in the

⁷ Office Action of June 11, 2009, page 3.
⁸ MPEP 1412.02 (I)(C).

original patent relates to a system configured to receive and execute a distributed computing application that alters an associated video program. Thus the current claims are drawn to a significantly different invention that that addressed by the claims of the original patent. This difference was recognized by the Examiner in the Office Action of May 3, 2007, but has never again been substantively addressed by the Examiner. Where, as here, reissue claims are claiming an additional invention not originally claimed, recapture is not present. Applicants therefore respectfully submit that under 35 USC § 251 and the guidance of the MPEP, recapture is not present in the present application; and Applicants respectfully request that the rejection be reversed.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 408-278-4052 to discuss any questions that may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of ~~October~~ October 2009

John D. Gustav-Wrathall
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Signature